

1 NOEL M. COOK (SBN 122777)
2 LINDA JOY KATTWINKEL (SBN 164283)
2 OWEN, WICKERSHAM & ERICKSON, P.C.
3 455 Market Street, Suite 1910
3 San Francisco, CA 94105
4 Tel: (415) 882-3200
4 Fax: (415) 882 -3232
5 Email: ncook@owe.com
5 Email: ljk@owe.com

6 DAVID DONAHUE (*pro hac vice* application forthcoming)
7 MELISSA GOLDSTEIN (*pro hac vice* application forthcoming)
8 JESSICA VOSGERCHIAN (*pro hac vice* application forthcoming)
9 **FROSS ZELNICK LEHRMAN & ZISSU, P.C.**
10 4 Times Square, 17th Floor
11 New York, New York 10036
Tel: (212) 813-5900
Fax: (212) 813-5901
Email: ddonahue@fzlz.com
Email: mgoldstein@fzlz.com
Email: jvosgerchian@fzlz.com

12 || Attorneys for Plaintiff

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

17 FUNDACIÓ GALA-SALVADOR DALÍ
18 Plaintiff,
19 v.
20 DALI AT 17 MILE DRIVE, LLC and
21 DMITRY PITERMAN,
22 Defendants.

COMPLAINT FOR:

- (1) Violation of California Civil Code § 3344.1
 - (2) Federal Trademark Infringement, 15 U.S.C. § 1114(1);
 - (3) Federal Unfair Competition, 15 U.S.C. § 1125(a)(1)(a);
 - (4) Copyright Infringement, 17 U.S.C. § 501;
 - (5) California Unfair Competition, Cal. Bus. & Prof. Code § 17200.

1 Plaintiff Fundació Gala-Salvador Dalí (the “Foundation”), by its undersigned attorneys, for
2 its complaint against Defendants Dali at 17 Mile Drive, LLC and Dmitry Piterman
3 (“Defendants”), alleges as follows:

4 **Nature of the Action**

5 1. This case arises out of Defendants’ willful infringement of Salvador Dalí’s name,
6 image, and associated intellectual property rights controlled by Plaintiff.

7 2. For decades, the Foundation has promoted and protected the art of world-renowned
8 artist Salvador Dalí. By order of the Kingdom of Spain, the Foundation has been designated to
9 exclusively manage and enforce the intellectual property rights arising from the works and person
10 of the world-famous artist Salvador Dalí. The Foundation has registered a claim with California’s
11 Secretary of State under California Civil Code Section 3344.1 as successor-in-interest to Mr.
12 Dalí’s post mortem right of publicity and owns several federal trademark registrations for marks
13 that consist of or include the word DALÍ.

14 3. Without authorization from the Foundation, Defendants have opened a museum
15 under the name and mark DALÍ17, have misappropriated Salvador Dalí’s name and likeness to
16 advertise and promote their museum, and have reproduced and displayed copyrighted artworks.
17 Defendants have been informed that their conduct is unlawful, but remain undeterred and continue
18 to advertise and provide goods and services infringing on the Foundation’s intellectual property
19 and publicity rights.

20 4. Accordingly, the Foundation now brings claims against Defendants for violation of
21 Salvador Dalí’s right of publicity under Cal. Civ. Code § 3344.1; trademark infringement in
22 violation of Section 32(1) of the Trademark Act of 1946 (the “Lanham Act”), 15 U.S.C. §
23 1114(1); false designation of origin and unfair competition in violation of Section 43(a)(1)(A) of
24 the Lanham Act, 15 U.S.C. § 1125(a)(1)(A); copyright infringement in violation of 17 U.S.C. §
25 501; and unfair competition in violation of California State Law, Cal. Bus. & Prof. Code §§ 17200
26 *et seq.* In connection with these claims, the Foundation seeks both injunctive and monetary relief.
27
28

Jurisdiction and Venue

2 5. The Court has jurisdiction over the subject matter of this action under Section 39(a)
3 of the Lanham Act, 15 U.S.C. § 1121(a), Section 501 of the Copyright Act, 17 U.S.C. § 501, and
4 Sections 1331 and 1338(a) and (b) of the Judicial Code, 28 U.S.C. §§ 1331, 1338 (a) & (b). This
5 Court has supplemental jurisdiction over the state law claims under Section 1337(a) of the Judicial
6 Code, 28 U.S.C. § 1337(a).

7 6. The Court has personal jurisdiction over Dali at 17 Mile Drive, LLC because Dali
8 at 17 Mile Drive, LLC maintains a place of business in California and regularly conducts its
9 business and offers its services in California.

10 7. The Court has personal jurisdiction over Dmitry Piterman because Piterman is a
11 resident of California.

12 8. Venue is proper under Section 1391(b) and (c) of the Judicial Code, 28 U.S.C.
13 § 1391(b) and (c), in that Dali at 17 Mile Drive, LLC resides in this District and a substantial part
14 of the events giving rise to the claims occurred in and are directed from this District.

15 9. Venue is proper under Section 1391(b) and (c) of the Judicial Code, 28 U.S.C.
16 § 1391(b) and (c), in that Dmitry Piterman resides in this District and a substantial part of the
17 events giving rise to the claims occurred in and are directed from this District.

Intradistrict Assignment

19 10. Intradistrict assignment is appropriate under Civil Local Rule 3-2(c) because this is
20 an Intellectual Property Action.

The Parties

22 11. Plaintiff Fundació Gala-Salvador Dalí is a private foundation existing under the
23 laws of Spain, with a place of business at Pujada del Castell 28, 17600 Figueres, Spain.

24 12. Upon information and belief, Defendant Dali at 17 Mile Drive, LLC is a limited
25 liability company existing under the laws of Nevada, with a place of business at 5 Custom House
26 Plaza, Monterey, CA 93940.

13. Upon information and belief, Defendant Dmitry Piterman is a resident of California with an address in Pebble Beach, California.

3 14. Upon information and belief, Defendant Piterman materially contributes to,
4 controls, and profits from the activities of Defendant Dali at 17 Mile Drive, LLC, including the
5 infringing and violative conduct described herein.

Facts Common to All Claims

A. Dalí Intellectual Property Rights

8 15. The Foundation was founded in 1983 at the express wish of Salvador Dalí to
9 promote, enhance, disseminate and protect the artist's artistic, cultural and intellectual works and
10 to preserve and protect the integrity of his life, name and image.

11 || 16. Salvador Dalí died on January 23, 1989.

12 17. Through a series of ministerial orders and agreements, including most recently on
13 October 10, 2011, the Kingdom of Spain – the sole heir of Salvador Dalí – has granted the
14 Foundation the exclusive authority to manage and enforce the intellectual property rights arising
15 from the works and person of Dalí, including, without limitation, copyrights, trademarks,
16 personality rights, and any other intangible rights.

17 18. In addition, for decades the Foundation has used marks that consist of or include
18 the word DALÍ (the “DALÍ marks”) in the United States in connection with museums, retail gift
19 shops, and various other goods and services.

20 19. The Foundation has invested a significant amount of time, effort and money in
21 developing and promoting its products and services offered under the DALÍ marks. As a result of
22 these efforts and the marketplace success of the products and services offered under the DALÍ
23 marks over the last decade, the DALÍ marks have come to identify the Foundation exclusively and
24 uniquely, and represents enormous goodwill.

25 20. In addition to the Foundation's extensive common law rights in the DALÍ marks,
26 the Foundation owns, among others, U.S. Trademark Registration No. 3,195,658 for the mark
27 DALÍ MUSEUM for use in connection with "museums; educational services, namely, classes in

1 fine art" in International Class 41 and in connection with "retail gift shops" in International Class
 2 35 (the "Registered DALÍ Mark").

3 21. The above registration is valid, subsisting and in full effect. Moreover, the above-
 4 referenced registration has become incontestable under Section 15 of the Lanham Act, 15 U.S.C.
 5 § 1065, and therefore serves as conclusive proof of the Foundation's exclusive right to use the
 6 Registered DALÍ Mark in connection with the goods and services identified therein, as provided
 7 by Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

8 22. The Foundation is the owner of exclusive rights under U.S. Copyright law in,
 9 among others, the following works of art: (i) "The Persistence of Memory" and (ii) "The Rose /
 10 Meditative Rose" (collectively, the "Dalí Works").

11 23. The Foundation also registered in California as successor-in-interest to Salvador
 12 Dalí's post mortem right of publicity, pursuant to California Civil Code § 3344.1.

13 **B. Defendants' Wrongful Conduct**

14 24. On July 7, 2016 Defendants opened a museum under the name DALÍ17, along with
 15 a logo that uses the name Dalí and an image of Salvador Dalí's face, as shown below (the
 16 "DALÍ17 mark"):



24 25. Defendants use the DALÍ17 mark and many images of Salvador Dalí and of his
 25 artworks, as well as his name, to advertise and promote their museum on their website and social
 26 media accounts.

27

28

1 26. In particular, Defendants have reproduced and are displaying the Dalí Works to
2 promote their museum on their website and social media accounts.

3 27. On information and belief, Defendants have reproduced the DALÍ17 mark on
4 merchandise which they are selling through their museum gift shop.

5 28. Defendants are using a name and mark that includes “DALÍ” for services identical
6 to and/or related to the services provided by the Foundation under its DALÍ marks.

7 29. Defendants’ DALÍ17 mark is confusingly similar to the Foundation’s DALÍ marks
8 in sight, sound and commercial meaning.

9 30. Upon information and belief, Defendants’ advertisement, promotion and offering of
10 its services and merchandise under its DALÍ17 mark are directed to the same consumers as the
11 goods and services offered by the Foundation under the DALÍ marks.

12 31. Defendants are not associated or affiliated with the Foundation and have never been
13 authorized or otherwise licensed by the Foundation to use the name or likeness of Salvador Dalí,
14 the DALÍ marks, or any trade names or trademarks confusingly similar thereto, in connection with
15 any goods or services.

16 32. Upon information and belief, Defendants selected and have used the DALÍ17 mark
17 with actual and constructive knowledge of the Foundation’s ownership of and exclusive rights to
18 use the name or likeness of Salvador Dalí and the DALÍ marks and with the intent to trade off of
19 the significant reputation of Salvador Dalí and of the goodwill symbolized by and the strong
20 industry recognition of the DALÍ marks.

21 33. Defendants commenced use of the DALÍ17 mark long after the Foundation
22 commenced use of the DALÍ marks, and long after the Foundation developed substantial goodwill
23 in the DALÍ marks. As such, the Foundation has priority.

24 34. Upon information and belief, Defendants’ conduct is intentional, willful and
25 wanton.

26

27

28

1 C. **Effect of Defendants' Conduct**

2 35. Defendants' unauthorized use of the DALÍ17 mark, Salvador Dalí's name and
3 likeness, and the Dalí Works for commercial purposes is damaging the Foundation.

4 36. As a result of Defendants' use of the DALÍ17 mark in connection with its museum
5 services and merchandise, the consuming public is likely to be confused, deceived and misled into
6 believing that services and merchandise offered under the DALÍ17 mark are offered, licensed,
7 authorized, endorsed or sponsored by the Foundation.

8 37. Further, the goodwill that the Foundation has built up in the DALÍ marks is put at
9 risk by Defendants' appropriation and use of the confusingly similar DALÍ17 mark. Defendants'
10 unauthorized acts unfairly and unlawfully wrest from the Foundation control over its DALÍ marks
11 and its reputation, particularly as the Foundation has no control over the quality of Defendants'
12 goods or services offered under the DALÍ17 mark. As a result, the Foundation's extremely
13 valuable reputation is being irreparably damaged. If Defendants' conduct is not enjoined, it will
14 continue to injure the value of the DALÍ marks and the ability of those marks to indicate goods
15 and services emanating from a single source, namely, the Foundation.

16 38. Defendants' infringing activities have caused and will continue to cause irreparable
17 damage to the business and goodwill of the Foundation unless permanently restrained by this
18 Court.

19 39. Defendants have actual knowledge that their conduct is unlawful. The Foundation
20 wrote to Defendant Piterman setting forth its well-established rights in the DALÍ marks,
21 copyrights in the Dalí Works, and rights of publicity in Salvador Dalí's name and likeness and
22 demanding that Mr. Piterman: (i) change the name of the DALÍ17 Museum to eliminate DALÍ
23 from it; (ii) permanently cease use of any name or mark that includes within it the word DALÍ;
24 (iii) agree never to register any DALÍ-inclusive marks for museum- or art- related goods or
25 services; (iv) cancel its registration for the dali17.com domain name; and (v) cease use of the Dalí
26 Works in the advertising and promotion of his museum. Defendant Piterman, however, refused to
27 comply.

40. The Foundation has no adequate remedy at law.

Count I: Violation of California Right of Publicity

Cal. Civ. Code § 3344.1

41. The Foundation repeats and realleges the allegations set forth in paragraphs 1 through 40 as if fully set forth herein.

42. Defendants have knowingly and intentionally misappropriated the name and
likeness of Salvador Dalí for the purpose of advertising and promoting their museum, and to sell
merchandise.

9 43. Salvador Dalí died on January 23, 1989.

10 44. Salvador Dalí's name and likeness had commercial value at the time of his death.

11 45. The Foundation is the successor-in-interest to Salvador Dalí's right of publicity
12 under California Civil Code Section 3344.1.

13 46. Defendants' misappropriation of Salvador Dalí's name and likeness for their own
14 commercial purposes is a violation of the Foundation's rights under California Civil Code Section
15 3344.1.

16 47. As a result of Defendants' actions, Plaintiff has suffered, and will continue to
17 suffer, damages in an amount to be proven at trial.

Count II: Federal Trademark Infringement

15 U.S.C. § 1114(1)

20 48. The Foundation repeats and realleges each and every allegation contained in
21 paragraphs 1 through 47 above as if fully set forth herein.

22 49. The Foundation's rights in the Registered DALÍ Mark developed long prior to any
23 use of the DALÍ17 mark by Defendants.

24 | 50. Defendants' DALÍ17 mark is confusingly similar to the Foundation's Registered
25 | DALÍ Mark.

26 51. The Foundation's services offered under the DALÍ17 mark are identical or closely
27 related to the goods and services offered by the Foundation under the Registered DALÍ Mark.

1 52. Defendants' actions described above are likely to cause confusion and mistake and
2 to deceive potential customers and the general public as to the source, origin, endorsement and/or
3 sponsorship of Defendants' services offered under the DALÍ17 mark, and are likely to deceive the
4 public into believing that such services are provided, authorized, endorsed or sponsored by the
5 Foundation, thereby damaging the Foundation's reputation, goodwill and sales.

6 53. Upon information and belief, Defendants' conduct is willful, deliberate and in bad
7 faith, and undertaken with full knowledge that Defendants have no right, license or authority to
8 use the Foundation's Registered DALÍ Mark or any trade name or mark confusingly similar
9 thereto.

10 54. Defendants' unauthorized use of the DALÍ17 mark is intended to reap the benefit
11 of the goodwill that the Foundation has developed in the Foundation's Registered DALÍ Mark and
12 constitutes trademark infringement in violation of Section 32(1) of the Lanham Act, 15 U.S.C.
13 § 1114(1).

14 55. Defendants' aforesaid conduct has caused and is causing irreparable injury to the
15 Foundation, and, unless enjoined by this Court, will continue both to damage the Foundation and
16 to deceive the public. The Foundation has no adequate remedy at law.

Count III: Unfair Competition and False

Designation of Origin Under 15 U.S.C. § 1125(a)(1)(A)

19 56. The Foundation repeats and realleges each and every allegation contained in
20 paragraphs 1 through 55 above as if fully set forth herein.

57. The Foundation's rights in the DALÍ marks developed long prior to any use of the
DALÍ17 mark by Defendants.

23 || 58. Defendants' DALÍ17 mark is confusingly similar to the Foundation's DALÍ marks.

24 59. The Foundation's services offered under the DALÍ17 mark are identical or closely
25 related to the goods and services offered by the Foundation under the DALÍ marks.

26 60. Defendants' conduct is likely to cause confusion or to cause mistake or to deceive
27 consumers, users and the public as to the affiliation, connection or association between Defendants

and the Foundation, and/or as to the origin, sponsorship, endorsement, or approval of Defendants' services.

61. Defendants' unauthorized use of the DALÍ17 mark falsely and misleadingly represents Defendants as being legitimately connected with and/or authorized by the Foundation, and places beyond the Foundation's control its own reputation and goodwill.

62. Upon information and belief, Defendants' conduct is willful, deliberate and in bad faith, and undertaken with full knowledge that Defendants have no right, license or authority to use any mark confusingly similar to the Foundation's DALÍ marks.

9 63. As a result of the foregoing, Defendants have falsely designated the origin of its
10 services offered under its DALÍ17 mark and have engaged in unfair competition in violation of
11 Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

12 64. Defendants' aforesaid conduct has caused and is causing irreparable injury to the
13 Foundation, and, unless enjoined by this Court, will continue both to damage the Foundation and
14 to deceive the public. The Foundation has no adequate remedy at law.

Count IV: Copyright Infringement

Under 17 U.S.C. § 501

17 65. The Foundation repeats and realleges each and every allegation contained in
18 paragraphs 1 through 64 as if fully set forth herein.

19 66. The Dalí Works were first created outside the United States, and do not qualify as a
20 “United States work” for purposes of Section 411 of the Copyright Act.

21 67. The Dalí Works are original and creative works protected under U.S. Copyright
22 Law.

23 68. Defendants, without the Foundation's authorization or consent, have reproduced
24 and displayed the Dalí Works on its website and social media pages to promote their museum.

25 || 69. Defendants had access to the Dalí Works.

1 70. Defendants have violated and, upon information and belief, continue to violate, the
2 Foundation's exclusive rights in the Dalí Works under Section 106 of the Copyright Act, 17
3 U.S.C. § 106, in violation of Section 501 of the Copyright Act, 17 U.S.C. § 501,

4 71. Defendants' aforesaid conduct has been undertaken knowingly, willfully and in bad
5 faith.

6 72. Defendants' infringement of the Foundation's exclusive rights in the Dalí Works
7 has caused the Foundation damage, and has enabled Defendants to profit illegally therefrom.

Count V: California Unfair Competition

Under Cal. Bus. & Prof. Code §§ 17200 *et seq.*

10 73. The Foundation repeats and realleges each and every allegation contained in
11 paragraphs 1 through 72 above as if fully set forth herein.

12 74. The aforesaid conduct of Defendants – trademark infringement and false
13 designation of origin – constitutes unfair competition in violation of Cal. Bus. & Prof. Code §§
14 17200 *et seq.*

15 75. Defendants' conduct is causing immediate and irreparable injury to the Foundation
16 and will continue both to damage the Foundation and deceive the public unless enjoined by this
17 Court. The Foundation has no adequate remedy at law.

18 || **WHEREFORE**, the Foundation demands judgment as follows:

19 1. Entering judgment for the Foundation on each of its claims.

20 2. Directing that Defendants, its officers, directors, agents, representatives, successors
21 or assigns, and all persons acting in concert or in participation with it, be immediately and
22 permanently enjoined from:

26 (b) infringing the DALÍ marks;

(c) falsely designating the origin, sponsorship, or affiliation of its business or services;

(d) using the DALÍ marks or any derivation or colorable imitation thereof, or any name or mark that is confusingly similar thereto, including the DALÍ17 mark (collectively, “Prohibited Marks”), in connection with the promotion, marketing, and offering of any goods or services;

(e) seeking to register any of the Prohibited Marks or any derivation or colorable imitation thereof, or any name or mark that is confusingly similar thereto;

9 (f) making or employing any other commercial use of any of the Prohibited
10 Marks;

24 (j) engaging in any other activity constituting unfair competition with the
25 Foundation;

(k) infringing the Dalí Works, including, without limitation, by reproducing, distributing, displaying, advertising, promoting, offering for sale, selling, importing or exporting any works copied or derived from the Dalí Works; and

6 3. Directing that Defendants deliver up to the Foundation's attorneys for destruction
7 all products, merchandise, labels, signs, stationery, prints, packages, promotional and marketing
8 materials, advertisements, and other materials currently in its possession or under its control
9 incorporating, featuring or bearing the Dalí name or image or the Prohibited Marks or any other
10 simulation, reproduction, copy, or colorable imitation thereof.

11 4. Directing that Defendants transfer or cause to be transferred to the Foundation
12 domain names owned by Defendants that incorporate the Dalí name or any of the Prohibited
13 Marks, including www.dali17.com, and execute all necessary documents to effectuate such
14 transfer(s).

15 5. Directing that Defendants file with the Court and serve upon the Foundation's
16 counsel within thirty (30) days after entry of judgment a report in writing under oath, setting forth
17 in detail the manner and form in which it has complied with the above.

18 6. Awarding the Foundation the greater of seven hundred fifty dollars (\$750) or the
19 actual damages suffered by the Foundation, as a result of Defendants' unauthorized use of
20 Salvador Dalí's name and likeness, and any of Defendants' profits from the unauthorized use.

21 7. Awarding the Foundation such damages it has sustained or will sustain by reason of
22 Defendants' acts of trademark infringement and unfair competition pursuant to 15 U.S.C. § 1117
23 and 17 U.S.C. § 504.

24 8. Awarding the Foundation all damages, including Defendants' profits, that are
25 recoverable under Cal. Bus. & Prof. Code § 17200 *et seq.*

26 9. Awarding the Foundation all other recoverable gains, profits, property, and
27 advantages derived by Defendants from its unlawful conduct.

1 10. Awarding to the Foundation exemplary and punitive damages to deter any further
2 willful infringement as the Court finds appropriate.

3 11. Awarding to the Foundation its costs and disbursements incurred in this action,
4 including reasonable attorneys' fees pursuant to 15 U.S.C. § 1117(a) and Cal. Civ. Code § 3344.1.

5 12. Awarding the Foundation interest, including pre-judgment interest on the foregoing
6 sums.

7 13. Awarding to the Foundation such other and further relief as the Court may deem
8 just and proper.

9
10 DATED: July 6, 2018

Respectfully submitted,

11
12 
13 NOEL M. COOK
14 LINDA JOY KATTWINKEL
15 OWEN, WICKERSHAM & ERICKSON, P.C.
16
17
18

19 FROSS ZELNICK LEHRMAN & ZISSU, P.C.
20 DAVID DONAHUE (*pro hac vice* application
forthcoming)
21 MELISSA GOLDSTEIN (*pro hac vice*
application forthcoming)
22 JESSICA VOSGERCHIAN (*pro hac vice*
application forthcoming)
23
24
25
26
27
28

Attorneys for Plaintiff